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09/469,567 12/22/99 PACE

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EXAMINER

TM02/0508

FLIESLER DUBB MEYER & LOVEJOY
FOUR EMBARCADERO CENTER
SUITE 400
SAN FRANCISCO CA 94111-4156

LE, U

ART UNIT

PAPER NUMBER

2171

DATE MAILED:

05/08/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/469,567

Applicant(s)
Pace et al

Examiner
Uyen Le

Art Unit
2171



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on _____
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on Dec 22, 1999 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892) 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) ☐ Other:

DETAILED ACTION

Drawings

1. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Specification

2. The abstract of the disclosure is objected to because "is disclosed" is used at line 6. The abstract is also objected to because it is not clear what e-mail applicant is referring to in "the e-mail" at lines 9-10. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 250 words. It is important that the abstract not exceed 250 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The specification is further objected to because at page 4, applicant specifies that Figure 1 is a block diagram indicating the system in filtering email to identify content in accordance with the prior art. This contradicts page 5 where applicant specifies that Figure 1 is a high level depiction of the present invention. Applicant is required to review the specification and drawings and make appropriate corrections.

Claim Objections

4. Claims 23-26 are objected to because of the following informalities: claim 23, line 3 contains typographical errors. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-22, 27, 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention because

- claim 1, line 5 "the file" lack antecedent basis
- claim 10, line 6 "the email" lacks antecedent basis
- claim 10, line 6 "said step" lacks antecedent basis
- claim 18, line 5 "said step" lacks antecedent basis
- claim 27, line 7 "the file" lacks antecedent basis
- claim 30 "said data file" lacks antecedent basis. Does applicant intend to make it dependent on claim 29?

The art rejection of claims 1-22, 27, 30 is applied as best understood in light of the rejection under 35 U.S.C. 112, second paragraph discussed above.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1, 2, 10, 11, 13, 18-21, 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Duvall et al (US 5,884,033).

Regarding claim 1, the claimed file content classification system merely reads on the system of Duvall filtering incoming and outgoing messages based on a comparison of data (see the abstract, Figure 3). The claimed digital ID generator and ID appearance database are met when Duvall shows that the system stores filtering information in a database. Clearly the filtering information has to be generated by an ID generator before being stored. The claimed characteristic comparison routine identifying the file as having a characteristic based on ID appearance in the appearance database is met when Duvall shows that the system compares portions of incoming and outgoing messages with filtering information stored in the database and determines appropriate actions (see column 1, lines 30-51, column 4, lines 22-36).

Regarding claim 2, a hashing algorithm is clearly present in the ID generator since the system hashes data such as serial numbers and domain names (see column 7, lines 40-46, column 8, lines 34-36).

Regarding claim 10, Duvall discloses a method for identifying a characteristic of a data file (see the abstract). The claimed generating a digital identifier for the data file, forwarding the identifier to a processing system and determining whether the forwarded identifier matches a characteristics of other identifiers are met when Duvall shows that the system compares portions of incoming or outgoing messages with filtering

information. The claimed processing emails based on the determination is met when Duvall shows that the system determines whether to block or allow transmission of the messages (see column 1, lines 30-51, column 4, lines 22-36).

Regarding claims 11, 13, the claimed hashing at least a portion of the data file and hashing multiple portions of the data file merely reads on the fact that the method of Duvall compares portions of a message and matches them to the filtering information (see column 1, lines 30-51).

Regarding claim 18, Duvall discloses a method of filtering an email message (see the abstract). The claimed processing the message to provide a digital identifier, comparing the digital identifier to a characteristic database of digital identifiers to determine whether the message has said characteristic and processing the message based on the comparison are met when Duvall shows that the system provides a list of IP addresses, compares IP addresses when a message is transmitted and allows or blocks accordingly (see Figure 3, column 4, lines 22-36).

Regarding claims 19-21, the claimed processing occurs on at least one first system or a plurality of first systems, comparing occurs on a second system and at least one first system and second system are coupled by the Internet merely read on the fact that any message sent from a system has an ID. Clearly the message ID is compared at the second system in the method taught by Duvall and both systems are coupled to the Internet (see Figures 1-4, column 1, lines 30-63).

Regarding claim 23, Duvall discloses a file content classification system (see the abstract). The claimed first system having a file to be classified is met by the system

sending emails. The claimed file ID generator on the first system is met by the fact that an IP address is generated and associated with a sent message. The claimed database on a second system coupled to the ID generator to receive IDs generated by the ID generator is met when Duvall shows that the system get a list of IP addresses (see Figure 3). The claimed comparison routine on the second system classifying the ID relative to the database as meeting or not meeting a characteristic is met when Duvall shows that the system compares IDs and act accordingly (see column 4, lines 22-36).

Regarding claim 24, the claimed plurality of first systems each including a respective file ID generator coupled to the database on the second system merely reads on the fact that email messages are sent and received from a plurality of systems.

Regarding claim 25, Duvall clearly shows that the first system is coupled to the second system via the Internet (see Figures 1, 2).

Regarding claim 26, Duvall discloses a web server interface 26 and database 22. Clearly the database system is isolated from the Internet by the web server system (see Figure 2).

7. Claims 27-30 are rejected under 35 U.S.C. 102(e) as being anticipated by Paul (US 6,052,709).

Regarding claim 27, Paul discloses a content classification system for a first and second computers coupled by a network (see Figure 1). The claimed client agent file identifier generator is met by the fact that each file received at a spam probe email address has an ID. The claimed server comparison agent and data structure on the

second computer receiving identifiers from the client agent and providing replies to the client agent is met by the fact that a spam control center monitors incoming mail to detect junk mail. The claimed wherein the client agent processes files based on replies from the server comparison agent merely reads on the fact that the system alerts all user terminals within the system once the junk mail is identified to allow user terminals to discard it (see the abstract).

Regarding claim 28, Paul discloses a method for providing a service on the Internet (see the abstract). The claimed collecting data from a plurality of systems having a client agent on the Internet to a server having a database is met when Paul shows that the system receives messages at spam probe email addresses. The claimed characterizing the data received relative to information collected in the database is met when Paul shows that the method detects junk mail. The claimed transmitting a content identifier to the client agent is met when Paul shows that the junk mail is identified and alert signals are sent to clients (see Figure 1).

Regarding claim 29, the claimed collecting a digital identifier for a data file merely reads on the fact that the method of Paul collects source identification of junk mail messages (see the abstract).

Regarding claim 30, clearly the data file is an email (see the abstract).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 3, 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duvall et al (US 5,884,033), in view of Butler et al (US 6,094,487).

Regarding claims 3, 12, although Duvall does not specifically show that the hashing algorithm is MD5, it is well known in the art to use MD5 hashing algorithm as shown by Butler (see column 4, lines 31-38). Since MD5 is commercially available, it would have been obvious to one of ordinary skill in the art to include MD5 hashing algorithm while implementing the system of Duvall in order to benefit from the readily available software on the market.

9. Claims 5-8, 16, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duvall et al (US 5,884,033).

Regarding claim 5, although Duvall does not specifically show a plurality of ID generators on different systems all coupled to and providing IDs to the appearance database, it would have been obvious to one of ordinary skill in the art to include them in order to integrate different systems available on the Internet.

Regarding claim 6, official notice is taken that the communication network comprises public and private networks. Therefore, it would have been obvious to one of ordinary skill in the art to include coupling a plurality of digital ID generators to the database via a combination of public and network in order to integrate all existing systems.

Regarding claims 7, 8, Duvall discloses web intermediate server 32 (see Figure 1).

Regarding claims 16, 17, Duvall discloses a plurality of source systems 10 all coupled via a network 14. Although Duvall does not specifically show that the sources systems are coupled to at least one processing system performing the determining step and that the processing step comprises instructing said plurality of source systems to perform an action on the email based on the determining step, it would have been obvious to one of ordinary skill in the art to do so in order to centrally control filtering for a plurality of interconnected systems.

10. Claims 4, 9, 14, 15, 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Duvall et al (US 5,884,033), in view of Cobb (US 6,199,102).

Regarding claim 4, although Duvall does not explicitly show that the ID appearance database tracks the frequency of appearance of a digital ID, it is well known in the art that mass commercial emailing is profitable and most ads can be repeatedly sent to thousands of people as shown by Cobb (see column 1, lines 40-64). Therefore, it would have been obvious to one of ordinary skill in the art to include such a feature while implementing the system taught by Duvall in order to detect unwanted messages.

Regarding claim 9, although Duvall does not specifically show that the characteristic comprises junk email and is defined by a frequency of appearance of a digital ID, it is well known in the art that senders of unsolicited emails try to reach as many recipients as possible as shown by Cobb (see column 1, lines 40-64). Therefore,

it would have been obvious to one of ordinary skill in the art to include junk email as characteristic and defining the characteristic by a frequency of appearance of a digital ID while implementing the system of Duvall in order to identify unsolicited junk emails.

Regarding claim 14, Duvall discloses that the data file is an email message but fails to show whether said email is spam. Cobb clearly shows that the method detects spam email (see the abstract). Since the method taught by Duvall filters messages, it would have been obvious to one of ordinary skill in the art to include determining spam email as taught by Cobb in order to alert recipients of spam email messages.

Claim 15 merely reads on the fact that mass commercial emailing is profitable and most ads can be repeatedly sent to thousands of people as shown by Cobb (see column 1, lines 40-64). Therefore, it would have been obvious to one of ordinary skill in the art to include tracking the rate at which a digital ID is generated while implementing the method of Duvall in order to detect unwanted junk mail.

Claim 22 merely reads on the fact that since mass mailers try to repeatedly send ads to people as shown by Cobb (see column 1, lines 40-64), it would have been obvious to one of ordinary skill in the art to include determining the frequency of a particular ID occurring in a time period, classifying said ID as having a characteristic and comparing digital identifiers to said ID as claimed in order to identify unwanted mailing messages in the method taught by Duvall.

11. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Paul (US 6,052,709), in view of Cobb (US 6,199,102).

Claim 31 merely reads on the fact that since mass mailers try to repeatedly send ads to people as shown by Cobb (see column 1, lines 40-64), it would have been obvious to one of ordinary skill in the art to include tracking the frequency of the collection of a particular identifier, characterizing the data file based on said frequency, storing the characterization and comparing collected identifiers to the known characterization as claimed in order to identify unwanted mailing messages in the method taught by Duvall.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lillibridge et al (US 6,195,698) teach a method for selectively restricting access to computer systems.

Meyerzon et al (US 6,199,081) teach automatic tagging of documents and exclusion by content.

Hull et al (US 5,465,353) teach image matching and retrieval by multi-access redundant hashing.

Syeda-Mahmood (US 6,178,417) teaches method and means of matching documents based on text genre.

Stockwell et al (US 6,144,934) teach a binary filelet using pattern recognition.

Metzger et al (US 5,515,513) teach disposition diltering of messages using a single address and protocol table bridge.

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Eidson et al (US 6,167,457) teach message filters, automatic binding and encoding for distributed systems.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Uyen T Le whose telephone number is 703-305-4134. The examiner can normally be reached on M-T 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Black can be reached on 305-9707. The fax phone numbers for the organization where this application or proceeding is assigned is 308-9051 for all communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 305-9000.

UL
May 2, 2001

JOHN C. LOOMIS
PATENT EXAMINER
GROUP 2800

